

### **Remarks**

Claims 1-39 and 52 are pending in the present application. By this Amendment, claims 1, 20, 25, 29, 30 and 36 are amended and all other pending claims are unchanged. Applicants request reconsideration in view of the amendments and the following remarks.

#### **I. Telephone Interview**

Applicants' attorney discussed the Office action with Examiner Nguyen in a telephone interview on January 20, 2006. Applicants appreciate the courtesies extended by Examiner Nguyen during the interview. The substance of the interview is discussed in the remarks below.

#### **II. 35 U.S.C. § 112 Rejection of Claims 1, 11, 20, 25, 29, 30 and 36**

Claims 1, 11, 20, 25, 29, 30 and 36 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for reciting the term "substantially constant." Applicants traverse this rejection.

Applicants disagree that the claim term "substantially" renders the claims indefinite. However, to facilitate prosecution, claims 1, 20, 25, 29, 30 and 36 have been amended to remove the term "substantially." Claim 11, as previously presented, does not include the term "substantially." Accordingly, the 35 U.S.C. § 112 rejection should be withdrawn.

#### **III. 35 U.S.C. § 102(b)/103(a) Rejection of Claims 1-39 and 52**

Claims 1-39 and 52 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or alternately, under 35 U.S.C. § 103(a) as allegedly being obvious from Japanese Patent No. 2001-191314 to Yoshiyuki (Yoshiyuki). Applicants traverse this rejection and request that it be withdrawn.

##### **Claims 1-10, 20-39 and 52:**

As discussed and agreed upon in the telephone interview, Yoshiyuki does not teach or suggest a mold cavity having a constant cross-section (claims 1, 20, and 25) or a mold wall having a constant thickness (claims 29, 30 and 36). Thus, claims 1, 20, 25, 29, 30 and 36 are allowable over Yoshiyuki. Dependent claims 2-10, 21-24, 26-28, 31-35, 37-39 and 52 depend

from claims 1, 20, 25, 29, 30 and 36 and therefore are allowable along with their respective base claims.

Claims 11-19:

Claim 11 recites an apparatus for molding and forming at least one roughened surface texture on an uncured masonry block. The apparatus comprises, *inter alia*, a mold including an interior surface defining at least one mold cavity having opposite end limits and rows of projections between the opposite end limits for contacting an uncured block in the mold. The projections are positioned side-by-side in each row, with each projection having a respective base that adjoins a base of an adjacent projection in the same row, and the rows of projections extending diagonally across the interior surface of the mold so as to define diagonally extending grooves between adjacent rows of projections, such that when the uncured block is removed from the mold cavity, the projections create a roughened texture on the surface of the uncured block. Yoshiyuki neither teaches nor suggests the instantly claimed apparatus.

In Yoshiyuki, the inside surfaces of mold walls 230 are formed with multiple protrusions 232 interspersed with concave dimples 233. The main object of Yoshiyuki's "invention" is to mold a concave-convex pattern of protrusions and dimples on the surface of a block. See, e.g., paragraph 0009 of Yoshiyuki. The protrusions 232 are not arranged side-by-side in diagonally extending rows, with the base of protrusion adjoining the base of an adjacent projection, as recited in claim 11.

Regarding the positioning of the projections in Applicant's device, the action contends: "[I]t would have been obvious to . . . rearrange the projections on the mold surface to form a desired embossing pattern on the block surfaces. It has been held that merely shifting the position of the parts without changing the operation of the mechanism will not render the claims patentable and the placement of the mechanism is an obvious matter of design choice." See page 3 of the action (citing *In re Japikse*, 181 F.2d 1019, 86 U.S.P.Q. 70 (CCPA 1950); *In re Kuhle*, 526 F.2d 553, 188 U.S.P.Q. 7 (CCPA 1975)). Applicants disagree with this contention for the following reasons.

First, the Yoshiyuki device cannot be modified in the manner recited in claim 11 without rendering the device unsuitable for its intended purpose. MPEP § 2143.01 states that references cannot be modified or combined if the proposed modification would render the prior art device unsatisfactory for its intended purpose or would change the principle of operation of the prior art

reference being modified. Yoshiyuki repeatedly states throughout the patent that an objective of the device is to provide a manufacturing process for forming a block with a concave-convex surface pattern. Arranging the protrusions 232 side-by-side in diagonally extending rows, with the base of protrusion adjoining the base of an adjacent projection, essentially would eliminate the concave dimples 233, and therefore, the mold would not be capable of forming a concave-convex pattern on the block, as required by Yoshiyuki's invention. Because the proposed modification would prevent the device from being used for its intended purpose, there is no teaching or suggestion to modify Yoshiyuki to derive the mold recited in claim 11.

The action contends that FIGS. 6-8 of Yoshiyuki teach that the surface of the mold can be changed to form different patterns on the blocks formed by the mold. See page 6, lines 3-4 of the action. FIG. 6 shows a block formed by the mold of FIGS. 1-5 and includes the concave-convex surface pattern across the entire front surface of the block. FIG. 7 shows an alternative mold plate having a flat upper portion 262 and a lower portion 263 formed with a plurality of projections 264 and concave dimples 265. FIG. 8 shows the block formed using this mold plate. The embodiment of FIGS. 7 and 8 includes the same pattern of projections and dimples as the embodiment of FIGS. 1-6, except that in the embodiment of FIGS. 7 and 8, the projections and dimples are confined to a lower portion of the mold plate. The formation of projections and dimples in the surface of the block is also a requirement of the embodiment of FIGS. 7-8. Nowhere in Yoshiyuki is there any support for eliminating the dimples or rearranging the positioning of the projections and dimples relative to each other to form a different pattern of projections and dimples.

Second, the arrangement of the projections recited in claim 11 does, in fact, "change the operation of the device." As discussed and agreed upon in the telephone interview, the Yoshiyuki mold, without any modification, would not produce a block with a roughened surface texture, as recited in claim 11. Exhibit A attached hereto includes photographs of a block formed with the instantly claimed apparatus. As shown in the photographs, when the mold is used in the manner recited in the claim (removing the uncured block from the mold), the surfaces of the block contacting the projections will be formed with a roughened surface texture resembling that of a split block (e.g., a fully cured block split with a chisel or splitting machine) or natural stone. Comparing the photographs of Exhibit A and FIG. 1 of the present application (FIG. 1 shows a mold wall with projections), it can be seen that the pattern of projections on the mold wall are

not cast into the surface of the block, as is the case for the blocks shown in FIGS. 6 and 8 of Yoshiyuki. Comparing the photographs of Exhibit A and FIGS. 6 and 8 of Yoshiyuki, one can clearly see that the arrangement of projections in Applicants device changes the operation of the device in that a roughened surface texture is formed on the block rather than an embossed surface pattern.

MPEP § 2144, p. 2100-134, provides that it is improper to rely solely on legal precedent as the rational to support an obviousness rejection if the facts of the prior legal decision are dissimilar to those of the application under examination or if the applicant has demonstrated the criticality of the limitation. In the present case, the rejection of claim 11 is based on legal precedent (see cases cited above) purportedly holding “that merely shifting the position of the parts without changing the operation of the mechanism will not render the claims patentable.” Since Applicants have demonstrated that the arrangement of projections in the apparatus of claim 11 does change the operation of the apparatus from that of Yoshiyuki (Yoshiyuki does not produce a roughened surface texture on a block), the legal precedent cited in the action is inapplicable to the present case, and therefore is insufficient to establish a *prima facie* case of obviousness of claim 11. If the Examiner disagrees, Applicants respectfully request clarification as to why Applicant has not demonstrated such a “criticality.” If there is some other basis for establishing a *prima facie* case of obviousness of claim 11, Applicants also request clarification as to that basis.

Accordingly, for the foregoing reasons, claim 11 is not anticipated or rendered obvious by Yoshiyuki and is allowable.

Claims 12-19 depend from claim 11 and are allowable for the reasons given above in support of claim 11 and because each dependent claim sets forth an independently patentable combination of features.

#### IV. Conclusion

The present application is in condition for allowance and such action is respectfully requested. If any further issues remain concerning this application, the Examiner is invited to call the undersigned to discuss such matters.

Respectfully submitted,

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